

Restriction Requirement

The Office Action has required restriction under 35 U.S.C. § 121 to one of the following inventions:

Group I: Claims 124-133, drawn to solvents, classified in various classes and subclasses.

Group II: Claims 134-137, drawn to fabric softening compositions, classified in class 510, subclass 515+.

Group III: Claim 138, drawn to fabric softening compositions, classified in class 510, subclass 515+.

Group IV: Claims 139-140, drawn to a concentrate and a process of making the same, classified in various classes and subclasses.

Group V: Claims 141-144, drawn to a process of making solvent mixtures, classified in various classes and subclasses.

Group VI: Claim 145, drawn to a fabric softening composition, classified in class 510, subclass 515+.

The Office Action alleges that the inventions in these various groups are distinct because of the following reasoning: Group I is distinct from Groups II, III, V and VI because the solvents of Group I are not required for the compositions or processes of the other groups. Group I is distinct from Group IV because Group IV recites components from Group I which are not recited in Group I. Distinctness among the remaining groups has not been alleged because it is asserted to be moot due to Applicants' provisional election.

Having elected one of Groups I-VI, the Office Action requires further restriction under 35 U.S.C. § 121 to one of the following groups:

Group A: Saturated aliphatic diols.

Group B: Unsaturated aliphatic diols.

Group C: Aromatic diols.

Group D: Hydroxymonoethers.

Group E: Alkoxylated diols.

The Office Action asserts that these groups are patentably distinct because disclosure of one of the groups would not anticipate or make obvious any of the other groups.

Having elected one of Groups A-E, the Office Action now requires further restriction under 35 U.S.C. § 121 to one of the following groups:

Group (a): Diols of 7 carbons.

Group (b): Diols of 8 carbons.

Group (c): Diols of 9 carbons.

The Office Action asserts that these groups are distinct because these classes of compounds are separately patentable and fall into different classes and subclasses.

In furtherance of Applicants' provisional election with traverse of Group IA in the telephonic election dated April 30, 2002, Applicants' hereby further elect Group IA(a) with traverse. As offered in the Office Action, Applicants desire that fabric softening compositions reciting non-zero amounts of allowed diols be considered as well, within the scope of the present election.

Applicants hereby traverse the present restriction requirement based on the following remarks.

Paramount to issuing a restriction requirement, the Manual of Patent Examining Procedure ("MPEP") describes the criteria for restriction as follows:

- (A) The inventions must be independent or distinct as claimed; and
- (B) There must be a serious burden on the examiner if restriction is required.

MPEP § 803 (7th ed. 1998) (citations omitted). Furthermore, the MPEP requires that "Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the requirement in most cases." MPEP § 803 (7th ed. 1998). Indeed, an Examiner must clearly provide reasons and/or examples to support how the Groups define inventions that are independent or distinct, and further to show how there is a serious burden on the Examiner. The present Office Action provides no reasoning or examples of how Groups A-E define inventions that are independent or distinct, and no reasoning or examples to show how there is a serious burden on the Examiner. Rather, the Office Action simply states that a disclosure of one of the groups would not anticipate or make obvious any of the other groups. There is no discussion as to how this renders the groups distinct.

Furthermore, with respect to the restriction between Groups (a)-(c), the Office Action supports the restriction by alleging that the classes of compounds are separately patentable and fall into different classes and subclasses. However, the Office Action fails to provide any reasoning, or even which classes and subclasses the compounds fall into, to support the conclusion that the inventions are distinct.

The Office Action then goes on to conclude that the claims contain inventions that are distinct and includes no discussion with regard to the burden on the Examiner. Since the Office Action provides no reasoning or examples as to how the inventions are allegedly distinct, this restriction requirement is improper.

Even if the claims in an application contain inventions that are independent or distinct, a proper restriction also requires that there be a serious burden on the Examiner. *See* MPEP § 803(B) (7th ed. 1998). As the MPEP explains:

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant.

MPEP § 803 (7th ed. 1998). Here, the Office Action does not provide the appropriate reasoning to support a *prima facie* case that a serious burden exists. Indeed, there is no discussion whatsoever as to the burden on the Examiner. Since a serious burden on the Examiner has not been *prima facie* shown, the present restriction requirement is improper.

With regard to the issue of burden on an Examiner, the MPEP recites that “where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.” MPEP § 808.02 (7th ed. 1998). With regard to the restriction between Groups (a)-(c), the Examiner has not set forth any discussion or reasoning as to the status in the art or field of search for each of the allegedly distinct inventions. *See* MPEP § 808.02(B)-(C) (7th ed. 1998). Since the classification and the field of search has not been shown to be different, the present restriction requirement is clearly improper under MPEP § 808.02.

Based on the above remarks, reconsideration and withdrawal of the restriction requirement is respectfully requested. If, upon reconsideration, this restriction requirement is made final, Applicants respectfully request the next Office Action contain Form Paragraph 8.05 as suggested in MPEP § 821.01 (7th ed. 1998), to show that Applicants have traversed the requirement and have retained the right to petition from the requirement under 37 C.F.R. § 1.144.


CONCLUSION

In view of the foregoing remarks, reconsideration of the application, withdrawal of the restriction requirement, and allowance of all claims are respectfully requested.

Respectfully submitted,

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